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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,054	11/06/2001	Merrit N. Jacobs	CDS-255	9036

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EXAMINER

GORDON, BRIAN R

ART UNIT PAPER NUMBER

1743

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



<b>Office Action Summary</b>	<b>Application No.</b> 09/993,054	<b>Applicant(s)</b> JACOBS ET AL.	
	<b>Examiner</b> Brian R. Gordon	<b>Art Unit</b> 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 21 September 2006.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 19-23 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 19-23 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on 06 November 2001 is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \*    c)  None of:
1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 18, 2006 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed October 30, 2006 have been fully considered but they are not persuasive. Applicant has now amended the claims to claim a combination of a probe, probe tip, and newly added pump. Applicant asserts the prior art reference of Byrd does not teach the use of the pipette with a pump for creating a partial pressure or vacuum, particularly in the context of an analyzing apparatus.

First, it should be noted applicant's claims are not directed to any specific analyzing apparatus nor do the claims include any limitations to substantiate in reference to the device as being classified as such. However, contrary to applicant's assertion the device of Byrd is disclosed as being employed for blood analysis.

As to incorporation of the pump, Byrd discloses the use of a suction tube 3 to which a mouthpiece 4 may be attached and an operator can provide suction in tube and pipette to draw blood therein in a well known manner (page 1, lines 85-90).

Furthermore, it is conventionally known in the art that piston cylinder structures are employed for aspirating and dispensing in syringe and pipette-like systems (as admitted by applicant in recognizing US Patent 5,773,305 as disclosing the claimed pump).

As such, the previous rejection as based upon Byrd is hereby maintained.

### ***Claim Interpretation***

3. The examiner notes the rotational motion of aspirated liquid caused by the varying diameters is a rotational motion in the vertical direction (figs. 2A-2C) not horizontally as commonly seen in washing machines, blenders, etc.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the combination of the probe, probe tip, and piston-cylinder pump must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 20-22 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Byrd US 1,547,562.

Byrd discloses a pipette assembly that comprises a tube (probe) attached to a variously-diametered pipette tip. As seen the figures the device structurally equivalent to that as claimed by applicant. The diameter of the diluting chamber 9 is used for agitation and appears to be at 3 times the diameter of the adjacent chambers.

As to incorporation of the pump, Byrd discloses the use of a suction tube 3 to which a mouthpiece 4 may be attached and an operator (pump) can provide suction in tube and pipette to draw blood therein in a well known manner (page 1, lines 85-90).

***Claim Rejections - 35 USC § 103***

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7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrd.

Byrd does not disclose the tip portion as a being configured as having the middle cavity being formed of removably mounted elements.

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that the tip portion may be manufactured to be assembled in multiple parts. It is conventionally known in the art that pipette tips may be manufactured to be disposable (prevention of cross contamination) as well as multiple pieces allow for ease of cleaning the device and ease of replacing parts rather than the entire device if only a portion is of the device is defective.

9. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrd as applied to claims 19-22 above, and further in view of Zabetakis et al., US 5,773,305 or in the alternative Elkins US 4,119,125.

Byrd does not specify the use of a piston-cylinder pump.

Zabetakis et al. and Elkins both disclose the use of a piston-cylinder pump assemble to aspirate and dispense a fluid such as blood.

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the device of Byrd may be modified to include a piston-cylinder assembly attached to the suction tube to provide the required suction therein.

### ***Conclusion***

10. No claims allowed.

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11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yao, Li; Hood; Robert Gordon; Lewis; Gregory D. et al.; Wilkins; Robert John et al.; and Sokol; Kurt Rudolf disclose piston-cylinder pump arrangements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



brg

BRIAN R. GORDON  
PRIMARY EXAMINER